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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.	
. 10/015,274	12/11/2001	Randolf von Oepen	JM-10 CIP	7012	
35023 75	35023 7590 10/17/2006			EXAMINER	
LUCE, FORWARD, HAMILTON & SCRIPPS LLP			HUGHES, ALICIA R		
11988 EL CAMINO REAL, SUITE 200 SAN DIEGO, CA 92130			ART UNIT	PAPER NUMBER	
,			1614		
			DATE MAILED: 10/17/2000	6	

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)			
	10/015,274	VON OEPEN, RANDOLF			
Office Action Summary	Examiner	Art Unit			
	Alicia R. Hughes	1614			
The MAILING DATE of this communication appears on the cover sheet with the correspondence address Period for Reply					
A SHORTENED STATUTORY PERIOD FOR REPLY WHICHEVER IS LONGER, FROM THE MAILING DA - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication. - If NO period for reply is specified above, the maximum statutory period v - Failure to reply within the set or extended period for reply will, by statute Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	ATE OF THIS COMMUNICATION 36(a). In no event, however, may a reply be timwill apply and will expire SIX (6) MONTHS from a cause the application to become ABANDONE	N. nely filed the mailing date of this communication. D (35 U.S.C. § 133).			
Status					
1) Responsive to communication(s) filed on 20 Se					
,					
3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11, 453 O.G. 213.					
closed in accordance with the practice under E	tx parte Quayle, 1955 C.D. 11, 40	13 O.G. 213.			
Disposition of Claims					
4) ⊠ Claim(s) 1-20 is/are pending in the application. 4a) Of the above claim(s) is/are withdraw 5) □ Claim(s) is/are allowed. 6) □ Claim(s) is/are rejected. 7) □ Claim(s) is/are objected to. 8) ⊠ Claim(s) 1-20 are subject to restriction and/or expressions.	wn from consideration.				
Application Papers					
9) The specification is objected to by the Examine 10) The drawing(s) filed on is/are: a) accomplicant may not request that any objection to the Replacement drawing sheet(s) including the correct 11) The oath or declaration is objected to by the Example 11.	epted or b) objected to by the I drawing(s) be held in abeyance. See tion is required if the drawing(s) is obj	e 37 CFR 1.85(a). jected to. See 37 CFR 1.121(d).			
Priority under 35 U.S.C. § 119					
 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f). a) All b) Some * c) None of: 1. Certified copies of the priority documents have been received. 2. Certified copies of the priority documents have been received in Application No 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)). * See the attached detailed Office action for a list of the certified copies not received. 					
Attachment(s) 1) Notice of References Cited (PTO-892) 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)	4) Interview Summary Paper No(s)/Mail Do 5) Notice of Informal F	ate			
Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date	6) Other:				

DETAILED ACTION

Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. §121:

I. Claims 1-13, drawn to a process of reducing restinosis, classified in class 514,

subclass 310.

II. Claims 14-20, drawn to a product designed to inhibit restenosis in patient vessels,

classified in class 514, subclass 310.

Inventions I and II are related as product and process of use. The product of Invention II,

a kit containing a moiety, a tubular structure, and a catheter, can be used to reduce restinosis, the

process claimed as Invention I.

The inventions can be shown to be distinct if either or both of the following can be

shown: (1) the process for using the product as claimed can be practiced with another materially

different product or (2) the product as claimed can be used in a materially different process of

using that product. See MPEP §806.05(h). In the instant case the product can be used in

materially different processes, for example, the treatment of coronary artery disease, valvular

heart disease, congestive heart failure, and/or catheter-based heart repair, from the process

claimed in Invention I. Since the product claimed in Invention II can be used in a process that

is materially different from the process for reducing restenosis, as claimed in Invention I,

restriction is proper.

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Rejoinder Notice

The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder. All claims directed to a nonelected process invention must require all the limitations of an allowable product claim for that process invention to be rejoined.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103 and 112. Until all claims to the elected product are found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowable product claim will not be rejoined. See MPEP § 821.04(b). Additionally, in order to retain the right to rejoinder in accordance with the above policy, applicant is advised that the process claims should be amended during prosecution to require the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder. Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

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Election

This application contains claims directed to the following patentably distinct species: a radioactive restenosis-inhibiting moiety and a neutron-capture restenosis-inhibiting moiety. The species are independent or distinct, because a radioactive restenosis-inhibiting moiety can inhibit cell growth and proliferation whereas a neutron-capture restenosis-inhibiting moiety may not.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 4-7, 10, 14, 19 and 20 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the

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inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. §103(a) of the other invention.

Election/Restrictions Proper

MPEP §809.02(d) states, "[w]here only generic claims are presented, no restriction [or election] can be required except in those applications where generic claims recite such a multiplicity of species that an unduly burdensome search is necessary." Here, the claims recite such a multiplicity of species that an unduly extensive and burdensome search would be necessary if all of the claimed species were to be examined simultaneously.

At the very least, if all claims were examined as presented, the examiner would have the undue burden of performing at least four different independent searches: (1) a method of reducing restenosis utilizing a radioactive moiety; (2) a method of reducing restenosis utilizing a neutron-capture moiety while exposing the stent to a neutron flux; (3) a product including a radioactive moiety; and (4) a product including a neutron-capture moiety. Each search would be capable of producing its own, independent invention.

It is easy enough to understand the variation between a search for a product versus a process. Within these subsets, however, lie yet another search variation – the neutron-capture moiety versus the radioactive moiety. Radioactive moieties respond differently than neutron capture moieties. For example, radioactive moieties are known for their ability to form excited molecules, thereby causing physical damage to cells and DNA. Additionally, radioactive moieties are capable of being traced through the body, precisely revealing a number of biochemical and metabolic processes, thereby aiding disease diagnosis and furthering research in

a manner distinct from neutron-capture moieties. As a result of these variable functions and properties, a concurrent search of neutron-capture moieties and radioactive moieties create an unduly extensive and burdensome search for the examiner.

In light of the foregoing, the claimed inventions are patently distinct and capable of supporting their own patents. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction and election for examination purposes as indicated is proper.

Because these inventions are independent or distinct for the reasons given above and there would be a serious burden on the examiner if restriction is not required because the inventions have acquired a separate status in the art due to their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In

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either instance, if the examiner finds one of the inventions unpatentable over the prior art, the

evidence or admission may be used in a rejection under 35 U.S.C.103(a) of the other invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Alicia Hughes whose telephone number is 571-272-6026. The

examiner can normally be reached from 9:00 AM to 5:00 PM, Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Ardin Marschel, can be reached at 571-272-0718. The fax number for the

organization where this application or proceeding is assigned is 571-273-6026.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR of Public PAIR. Status information for unpublished

applications is available through Public PAIR only. For information about the PAIR system, see

http://pair-direct-uspto.gov. Should you have questions on access to the Private PAIR system,

contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like

assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

29 September 2006

ARH

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